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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,848	11/12/2003	Graham Hughes	05-03-010	6082
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,848	HUGHES ET AL.	
	Examiner	Art Unit	
	Eric B. Kiss	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 November 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-21 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 12 November 2003 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20040915, 20060313.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application
6) Other: ____.

DETAILED ACTION

1. Claims 1-21 have been examined.

Drawings

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 8-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or

mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1760 (claim to a data structure *per se* held nonstatutory).

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. *See, e.g.*, *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, *i.e.*, the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035.

Claims 8-14 recite “data processing systems” comprising a series of means that can be reasonably interpreted as software, *per se*. (See Specification at p. 14, lines 11-14.) The claims do not otherwise define any structural and functional interrelationships between the software elements and a computer that would permit the described functionality to be realized when the software is employed as a computer component.

Claims 15-21 set forth computer program products tangibly embodied in machine-readable media. Applicant’s specification describes such machine-readable media (“machine usable mediums” [sic]) as embracing transmission type media such as digital and analog communications links, *i.e.*, signals encoded with functional descriptive material. (Specification p. 14, lines 17-24.) The Office’s current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. See 1300 OG 142 (November 22, 2005) (in particular, see Annex IV(c)).

5. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. §101 (non-statutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Nos. 6,112,225 (Kraft et al.) and 6,360,268 (Silva et al.).

Regarding claim 1, *Kraft et al.* discloses:

receiving a [] request (*see, e.g., Kraft et al.* at col. 9, lines 1-27);

sending executable program code, corresponding to the [] request, to a client system (*see, e.g., Kraft et al.* at col. 9, lines 1-27);

receiving a response from the client system indicating that the client system will perform a [task], and indicating that the client system was not being actively used when the executable program code was sent (*see, e.g., Kraft et al.* at col. 9, lines 1-27).

Kraft et al. discloses a task distribution process as described above, but fails to expressly disclose the distributed task being a testing task. However, in a similar task distribution process, *Silva et al.* teaches the distribution of testing tasks in order to achieve more efficient testing. *See, e.g., Silva et al.* at col. 1, lines 22-48; col. 2, line 63, through col. 3, line 17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the task distribution of *Kraft et al.* and *Silva et al.* as part of a test request distribution system in order to gain the benefits of efficient testing.

Regarding claim 2, *Kraft et al.* further discloses executable program code, corresponding to the [] request, is sent to multiple client systems (*see, e.g., Kraft et al.* at col. 7, lines 29-31). Therefore, for reasons stated above, such a claim also would have been obvious.

Regarding claim 3, *Kraft et al.* further discloses retrieving a list of client system identifiers, the client system identifiers indicating client systems to which executable program

code can be sent for [processing] (see, e.g., *Kraft et al.* at col. 7, lines 29-41). Therefore, for reasons stated above, such a claim also would have been obvious.

Regarding claim 4, *Kraft et al.* discloses:

receiving executable code from a server system in a client data processing system (see, e.g., *Kraft et al.* at col. 9, lines 1-27);
if the client data processing system is in an idle state when the executable code is received, then sending a response to the server system, [processing] at least a portion of the executable code, and sending [] results to the server system (see, e.g., *Kraft et al.* at col. 9, lines 1-35).

Kraft et al. discloses a task distribution process as described above, but fails to expressly disclose the distributed task being a testing task. However, in a similar task distribution process, *Silva et al.* teaches the distribution of testing tasks in order to achieve more efficient testing. See, e.g., *Silva et al.* at col. 1, lines 22-48; col. 2, line 63, through col. 3, line 17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the task distribution of *Kraft et al.* and *Silva et al.* as part of a test request distribution system in order to gain the benefits of efficient testing.

Regarding claim 5, *Kraft et al.* further discloses if the client data processing system is not in an idle state when the executable code is received, then no response is sent to the server and no [processing] is performed (see, e.g., *Kraft et al.* at col. 9, lines 36-55). Therefore, for reasons stated above, such a claim also would have been obvious.

Regarding claim 6, in addition to the teachings applied above, *Silva et al.* further teaches the testing being a coverage analysis test (see, e.g., *Silva et al.* at col. col. 1, lines 22-48). Therefore, for reasons stated above, such a claim also would have been obvious.

Regarding claim 7, *Kraft et al.* further discloses the client data processing system is in an idle state when no user is actively operating the client data processing system (see, e.g., *Kraft et al.* at col. 8, lines 47-67). Therefore, for reasons stated above, such a claim also would have been obvious.

Regarding claims 8-21, these are data processing system and computer program product claims substantially paralleling the limitations in claims 1-8. *Kraft et al.* further discloses the use of such data processing systems and computer program products in implementing the prescribed methods, see, e.g., *Kraft et al.* at Figures 3 and 4, and all other limitations have been addressed as set forth above. Therefore, for reasons stated above, such claims also would have been obvious.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (571) 272-3699. The Examiner can normally be reached on Tue. - Fri., 7:00 am - 4:30 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2192

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature should be directed to the TC 2100 Group receptionist: 571-272-2100.



Eric B. Kiss
September 10, 2007